

## REMARKS

Based on the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner has rejected claims 1-3 and 5 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,914,882 (Yeghiazarians), under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,415,875 (Meixner) and under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,863,165 (Koslowsi). Applicants respectfully disagree with this rejection.

Yeghiazarians fails to disclose any alternately opened and closed clutch, as required by claim 1. Yeghiazarians only discloses an only opened safety clutch to interrupt the action of the kinetic energy stored in the rotor of the motor on the jammed rotating spindle in a sudden manner (immediately at a dangerous event) (2:66-3:1). Thus, claim 1 is novel over Yeghiazarians. Yeghiazarians also fails to disclose an opening/closing frequency span including 100Hz of the clutch. The 100Hz (2:56-62) referred to by the Examiner are only inside the useful measuring band of the vibration sensor range. Claim 1 which is limited to an alternately opened and closed clutch is also novel over Yeghiazarians because any alternately opened and closed clutch would

contradict Yeghiazarians' solution of having an only opened safety clutch to in a sudden matter interrupt the action whereas the clutch of the invention could be closed in the sudden matter situation resulting in a dangerous situation. Thus, one skilled in the art viewing Yeghiazarians would think in opposition to the claimed invention.

The same argument holds for Koslowski since such reference also does not disclose any alternately opened and closed clutch but only an opened (torque dependent) safety clutch which stays in this position until a new start is initiated. Meixner does not disclose any clutch but a solution to economize the idle clutch (1:34).

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation … [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck

& Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Since each reference fails to disclose each and every feature of independent claim 1, each such reference, as a matter of law, does not anticipate the present invention, as defined by said independent claim. In view of the above, it is respectfully submitted that such references do not anticipate or make obvious the present invention as defined in claim 1, and the present invention is patentable over such references. Claims 3 and 5 depend on claim 1 and are allowable for the same reasons claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 1 are not disclosed or suggested in the prior art.

The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Yeghiazarians in view of U.S. Patent No. 5,868,208 (Peisert) and claims 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over anyone of Koslowski or Meixner in view of Peisert. Applicants respectfully disagree with these rejections.

*A prima facie case of obviousness has not been met by the Examiner.*

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

*In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also *In re Sernaker*, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983):

SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. In re Jones 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that the teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” In re Sponnoble, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . .

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In addition to the arguments raised above with respect to the 35 USC 102 rejection of the claims, Applicants respectfully submit that Peisert also fails to disclose or teach any alternately opened and closed clutch.

In view of the above, it is respectfully submitted that none of the references alone or in combination make the present invention, as defined in claim 2 and 4, obvious, and the present invention is patentable over such references.

## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,



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